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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/922,645	08/07/2001	Kotaro Yamaguchi	35.C15656	9249
5514	7590	08/24/2005	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			LETT, THOMAS J	
			ART UNIT	PAPER NUMBER
			2626	

DATE MAILED: 08/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/922,645

**Applicant(s)**

YAMAGUCHI, KOTARO

**Examiner**

Thomas J. Lett

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 41-80 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 47-50, 57-60, 62, 67-70 and 77-80 is/are allowed.
- 6) ☒ Claim(s) 41-46, 51-56, 61, 63-66 and 71-76 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 17 June 2005.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: Detailed Action.

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments with respect to claims 1-40 have been considered but are moot in view of the new ground(s) of rejection and new claims 41-80.

### ***Allowable Subject Matter***

2. Claims 47-50, 57-60, 62,67-70, and 77-80 are allowed.

The following is a statement of reasons for the indication of allowable subject matter: Although the prior art of Horvitz receives email messages and truncates the lengths of the messages, the apparatus of Horvitz does not discriminate a non-printing of an received e-mail message if the e-mail exceeds a set print limit.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 41-46, 51-56, 61, 63-66, and 71-76 are rejected under 35 U.S.C. 102(e) as being anticipated by Hull et al (USPN 6,704,118 B1).

With respect to claim 41, Hull et al disclose an E-mail printing apparatus (office machine network of Fig. 1) comprising:

a reception unit (Email Server 116, col. 3, lines 38-39), adapted to receive E-mail;

a limiting unit (list 502 of options permits selection as to whether the full document is to be printed, only a specified range of pages, or only text that has been highlighted using a pointing and selection device such as a mouse, col. 7, lines 6-10), adapted to limit a printing of the E-mail received by said reception unit;

a discrimination unit (list 502 of options permits discrimination as to whether the full document is to be printed, col. 7, lines 6-8) adapted to discriminate whether or not a limited printing of the E-mail is to be performed; and

a transmission unit (keypad 604 is adapted to send a document to a destination(e.g., a source or a reply destination), col. 7, lines 48-50), adapted to transmit the E-mail to a transmitting source or a reply destination if said discrimination unit discriminates that the limited printing of the E-mail is not to be performed,

wherein said limiting unit prints the E-mail up to a predetermined amount if said discriminating unit discriminates that the limited printing of the E-mail is to be performed (list 502 of options permits selection as to whether the full document is to be printed, only a specified range of pages, or only text that has been highlighted using a pointing and selection device such as a mouse, col. 7, lines 6-10).

With respect to claim 42, Hull et al disclose an E-mail printing apparatus (office machine network of Fig. 1) comprising:

a reception unit (Email Server 116, col. 3, lines 38-39), adapted to receive E-mail;

a limiting unit (list 502 of options permits selection as to whether the full document is to be printed, only a specified range of pages, or only text that has been highlighted using a pointing and selection device such as a mouse, col. 7, lines 6-10), adapted to limit a printing of the E-mail received by said reception unit;

a discrimination unit, adapted to discriminate whether or not a limited printing of the E-mail is to be performed, wherein if said discrimination unit discriminates that the limited printing is to be performed and the E-mail exceeds a predetermined amount, said limiting unit does not print the E-mail, wherein if said discrimination unit discriminates that the limited printing of the E-mail is to be performed and the E-mail does not exceed the predetermined amount, said limiting unit prints the E-mail (list 502 of options permits discrimination as to whether the full document is to be printed, only a specified range of pages, or only text that has been highlighted using a pointing and selection device such as a mouse, col. 7, lines 6-10), and

wherein if said discrimination unit discriminates that the limited printing of the E-mail is not to be performed (when no text is selected using list 502 of options the full document (e-mail) will be printed, col. 7, lines 6-10), said limiting unit prints the E-mail.

With respect to claim 43, Hull et al disclose an E-mail printing apparatus (office machine network of Fig. 1) comprising:

a reception unit (Email Server 116, col. 3, line 38-39), adapted to receive E-mail;

a setting unit, adapted to set a print limit (list 502 of options permits selection whether the full document is to be printed, only a specified range of pages, or only text

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that has been highlighted using a pointing and selection device such as a mouse, col. 7, lines 6-10); and

a print unit (printer 112, col. 7, lines 20-22), adapted to print the E-mail received by said reception unit up to the print limit set by said setting unit.

With respect to claim 44, Hull et al disclose an apparatus according to Claim 43, wherein said setting unit sets the print limit for the number of print sheets (list 502 of options permits the user to select whether the full document is to be printed, only a specified range of pages, col. 7, lines 6-10).

With respect to claim 45, Hull et al disclose an apparatus according to Claim 43, wherein said setting unit sets the print limit for the number of lines (list 502 of options permits the user to select whether the full document is to be printed, only a specified range of pages, or only text that has been highlighted using a pointing and selection device such as a mouse, col. 7, lines 6-10).

With respect to claim 46, Hull et al disclose an apparatus according to Claim 43, further comprising a discrimination unit, adapted to discriminate whether or not the E-mail exceeds a predetermined amount (list 502 of options permits discrimination as to whether the full document is to be printed, only a specified range of pages, or only text that has been highlighted using a pointing and selection device such as a mouse, col. 7, lines 6-10),

wherein said setting unit (list 502) sets the print limit in accordance with a discrimination result obtained by said discrimination unit.

Claim 51, a method claim, is rejected for the same reason as claim 41.

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Claim 52, a method claim, is rejected for the same reason as claim 42.

Claim 53, a method claim, is rejected for the same reason as claim 43.

Claim 51, a method claim, is rejected for the same reason as claim 41.

Claim 61, a medium storing a program claim, is rejected for the same reason as claim 41.

Claim 63, a medium storing a program claim, is rejected for the same reason as claim 43.

Claim 64, a medium storing a program claim, is rejected for the same reason as claim 44.

Claim 65, a medium storing a program claim, is rejected for the same reason as claim 45.

Claim 66, a medium storing a program claim, is rejected for the same reason as claim 46.

Claim 71, a computer program embodied on a storage medium claim, is rejected for the same reason as claim 41.

Claim 72, a computer program embodied on a storage medium claim, is rejected for the same reason as claim 42.

Claim 73, a computer program embodied on a storage medium claim, is rejected for the same reason as claim 43.

Claim 74, a computer program embodied on a storage medium claim, is rejected for the same reason as claim 44.

Claim 75, a computer program embodied on a storage medium claim, is rejected for the same reason as claim 45.

Claim 76, a computer program embodied on a storage medium claim, is rejected for the same reason as claim 46.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Lett whose telephone number is (571)272-7464. The examiner can normally be reached on 7-3:30pm.

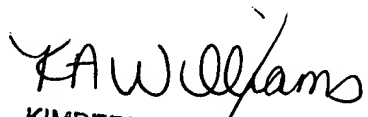


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A. Williams can be reached on (571)272-7471. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TJL

  
KIMBERLY WILLIAMS  
SUPERVISORY PATENT EXAMINER